

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/853,787

the claims. Upon allowance, it is requested that the Examiner renumber the claims, as appropriate. See 37 C.F.R. §1.126 and MPEP §1302.01.

In Paragraph No. 3 of the Office Action, Claims 2-5 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over either JP 11-166164 or Applicants' alleged admissions regarding the prior art (specification, page 1), each taken in view of XP 002191577 for the reasons set forth in Paragraph No. 3 of the prior Office Action.

It is asserted that a roughness parameter recited in Claim 3 is within the skill of the art, and that U.S. Pat. Appln. Pub. 2001/0020515A1 teaches that superior adhesion can be obtained when surface roughness of one micron or finer exists (page 2, paragraph 12).

It is conceded that each of the primary references lacks a teaching of the claimed surface resistivity performance parameter, i.e., a minimal level of antistatic behavior (page 3 of the Office Action of August 1, 2002).

Applicants respectfully traverse the rejection.

Applicants respectfully submit that XP '577 cannot be used as prior art with regard to the low antistatic values it claims, because it is nonenabling with respect to how to obtain the low antistatic values it claims to teach, as discussed in Remarks of the Amendment under 37 C.F.R. §1.111 filed on November 1, 2002.

Specifically, Applicants emphasize that neither JP '164 nor the allegedly admitted prior art teaches the specific properties of a heat-peelable pressure-sensitive adhesive layer, i.e., surface resistivity and maximum surface roughness. Moreover, none of these references suggests that adhesive force may be improved by controlling the surface resistivity and

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maximum surface roughness values of the adhesive layer in certain ranges. Accordingly, Applicants submit that a person of ordinary skill in the art would have no reason to modify the disclosure of these references in order to obtain improved adhesion.

In view of the above, the Examiner is respectfully requested to reconsider and withdrawn the rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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